

REMARKS

Claims 1-17 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Applicants would like to thank the Examiner for courtesy extended during the interview on May 25, 2006.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-3, and 5-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaidi (U.S. Pat. No. 6,601,126) in view of Loafman (U.S. Pub. No. 2005/0021916). This rejection is respectfully traversed.

With respect to Claim 1, the Examiner **admits** that the primary Zaidi reference does not show, teach or suggest a memory storage system including a line cache including a plurality of pages that are accessed by the first CPU, wherein when a miss occurs, n pages of said line cache are loaded with data from sequential locations in a first memory device, wherein n is greater than one.

As best understood, the Loafman reference does not specifically relate to the operation of line cache. Rather, Loafman relates to the operation of external random access memory (RAM) which is not line cache. Loafman divides virtual memory into pages. Loafman describes the use of cache memory in addition to the RAM **but does not appear to teach or suggest dividing the line cache into pages**. For example, cache is discussed in [0037] and [0041] of Loafman.

A reference must be considered for all that it teaches including disclosures that point towards the invention and disclosures that teach away from the invention. *In re Dow*, 5 USPQ.2d 1529 (Fed. Cir. 1988). It is improper to take teachings in the prior art out of context and give them meanings that they would not have to those skilled in the art. *In re Wright*, 9 USPQ.2d 1649 (Fed. Cir 1989). It is impermissible to pick and choose from a reference on so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the reference fairly teaches to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 USPQ 416 (Fed. Circ. 1986).

Here, the Loafman reference describes with particularity using external RAM as virtual memory that is divided into a plurality of pages. The same Loafman reference describes the use of cache in a conventional sense. The Examiner is incorrectly attempting to equate the cache and external RAM of Loafman in his rejection. Loafman, however, does not treat them equally as evidenced by a lack of discussion relating to applying the division of virtual memory in external RAM into pages to the cache. Therefore, Applicants respectfully assert that the proposed use of Loafman is not proper for these reasons.

It is a longstanding rule that to establish a prima facie case of obviousness of a claimed invention, **all of the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 143 (CCPA 1974), see MPEP §2143.03. Here, the Examiner fails to provide **any** reference to support dividing a **line cache** into pages. Furthermore, when evaluating claims for obviousness under 35 U.S.C. §103, all of the limitations must be considered and given weight. *Ex parte Grasselli*, 231 USPQ 393

(Bd. App. 1983), MPEP § 2144.03. Here, it is clear that the Examiner has given little or no consideration of the limitation **and failed to give the limitation any weight.**

It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. **Panduit Corp. v. Dennison Mfg. Co.**, 1 USPQ2d 1593 (Fed. Cir. 1987). Both the **suggestion and the expectation of success** must be founded in the prior art and not in Applicant's disclosure. **In re Farrell**, 7 USPQ2d 1673 (Fed. Cir. 1988). None of this evidence has been presented by the Examiner.

Applicant respectfully asserts that the Examiner has failed to clearly and particularly support his alleged motivation to combine these references using actual evidence as required. According to established mandates of the patent laws, "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." **M.P.E.P. § 2142**. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." **M.P.E.P. § 2143.01**.

"The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." **In re Kotzab**, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The showing must be "clear and particular, and it must be supported by **actual evidence**." **Teleflex, Inc. v. Ficosa North American Corp.**, 299 F.3d 1313, 1334, 63 U.S.P.Q.2d 1374, 1387 (Fed. Cir. 2002) (quoting **In re Dembiczak**, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999)) (emphasis added).

It is not sufficient to rely on “common sense and common knowledge,” as there must be specific evidence to support the motivation. In re Lee, 277 F.3d. 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002)]. It is respectfully submitted that the Patent Office has not made a legally sufficient showing of a motivation to combine Zaidi and Laufman based on actual, specific, evidence.

Rather, according to M.P.E.P. § 2142, “[t]o reach a proper determination under 35 U.S.C. 103, . . . impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art.” Furthermore, according to M.P.E.P. § 2143.01, “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification].” In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Since the Patent Office has offered no proper support or motivation for combining the references, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon “knowledge gleaned only from applicant's disclosure.” **M.P.E.P. § 2145.** Consequently, it is respectfully submitted that the rejection **entails hindsight and is, therefore, improper.**

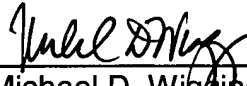
Claim 1 is allowable for at least the foregoing reasons. Claims 5, 10 and 13 are allowable for at least similar reasons as Claim 1. The remaining claims ultimately depend from Claims, 1, 5, 10, and 13 and are allowable for at least similar reasons.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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